

REMARKS/ARGUMENTS

Claims 4-7, 10-12, 15-17, 22-25, 28-30, 33-35, 40-43, 46-48 and 53-54 remain pending in the instant application.

At the outset, Applicant notes with appreciation that there is no rejection of independent claim 41 or 43. Applicant therefore presumes these claims to be allowable.

Rejection under 35 U.S.C. § 112

Claims 3, 17 and 39 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. Claims 3 and 39 are cancelled, without acquiescing in the propriety of the rejection, and without disclaimer or prejudice to the subject matter of the claims or their subsequent re-presentation in this or a continuing application.

Regarding claim 17, the Office Action avers that “transfer speed of downloading is adjusted” is unclear. Without limitation, that claim term finds antecedent basis in the specification, for example at p. 24, lines 14-21, stating “Control by packet scheduling means to adjust the download speed of a plurality of files in order to achieve a specific purpose.” Notwithstanding, and without acquiescence in the propriety of the rejection, Claim 17 is amended above to recite “data transfer speed while downloading is adjusted...” This amendment is solely to improve the clarity of the claim, and no alteration of claim scope from originally filed is intended nor should be inferred.

In light of the foregoing amendments to the claims, Applicant kindly requests favorable reconsideration and withdrawal of the rejections.

Rejection under 35 U.S.C. § 102

Claims 3, 5-6, 10, 17-18, 21, 23-24, 28, 35-36, 39, 42, 46 and 53-54 are rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 6,892,354 to Servan-Schreiber, *et al.* (“Servan”). Applicant respectfully traverses the rejection, for at least the following reasons.

Regarding Claim 3, this claim is cancelled without acquiescing in the propriety of the rejection, and without disclaimer or prejudice to the subject matter of the claim or its subsequent re-presentation in this or a continuing application.

Regarding Claim 5, the claim is amended above to recite “personal history information comprises reply history information to questions.” The Office Action states that all the features

of Claim 5 of the present application are disclosed by Servan (Paragraph No.7). The Office Action further states that Servan “teaches... based on said personal history information, wherein said personal history information comprises: advertisement access history”.

In view of the foregoing amendment, Applicant would like to note that Servan describes the advertisement access history, and Servan does not disclose "reply history information for questions". Therefore, Servan does not disclose Claim 5 of the present application. The present application has a significant advantage in that it is possible to “display advertisements that especially appeal to users” (Specification, p. 3) due to “reply history information for questions” (e.g., Specification, p. 10, line 8). Therefore, Applicant believes that Claim 5 of the present application is patentably distinguished over Servan, and therefore allowable. It should be noted that Claim 41 is amended in the same manner as Claim 5 above.

Regarding claims 6 and 24, the Office Action states that all the features of claims 6 and 24 of the present application are disclosed by Servan (Paragraph No.8) because Servan discloses "personal history information contains the content or type of data transferred by the user (i.e. what keywords are searched and which sites are accessed), advertisements presented to the user, or the user's personal characteristics information (i.e. statistical profile (col. 4 lines 50-60)". However, Applicant respectfully disagrees.

As amended above, claims 6 and 24 recite “personal information contains personal characteristic information indicating a person's characteristics, which is an arbitrary combination of name, age, gender, address, occupation, family structure...” This is supported in the original specification, as filed, for example at p. 9, line 20 – p. 10, lines 11, which state “The advertisement server side equipment 20 comprises: ... The personal information contains personal characteristic information indicating a person's characteristics, which is an arbitrary combination of name, age, gender, address, occupation, family structure and the like...” Such information is not the same as statistical profiles because “name, age, gender, address, occupation, family structure” are related to the specific user, and are not statistical. Therefore, the applicant would like to insist that Servan does not disclose Claims 6 and 24 of the present application.

Regarding Claim 10, the Examiner states that all features of Claim 10 of the present application are disclosed by Servan (Paragraph No.9). However, Claim 10 of the present application depends on Claim 4, and incorporates all of its features by reference. Therefore,

although claim 10 is separately patentable, in the interest of brevity, the Applicant believes that Claim 10 should be allowed for at least the same reasons as Claim 4.

Regarding Claim 17 (paragraph No. 10), the Office Action states that all the features of Claim 17 of the present application are disclosed by Servan (Paragraph Nos. 10, 47). The Office Action further states that in Servan “transfer speed of downloading is adjusted based on the state of presentation of the advertisement while data is transferred between said server and said user side equipment via said network (col. 3 lines 30-67 and col. 4 lines 1-13).” However, Applicant respectfully disagrees.

In accordance with Servan-Schreiber, “...to prevent the non-display of an advertising page between the display of content web pages, two or more advertising pages are downloaded... Then, one or more downloaded advertising pages are displayed until the new content web page is ‘sufficiently’ downloaded, and the not yet displayed downloaded advertising pages remain stored in user terminal 24’s memory (RAM, hard-drive, etc.) and remain undisplayed until the next user request to retrieve a new content web page...” (Col. 3, lines 44-67). Applicant respectfully submits that Servan does not adjust the data transfer speed. In Servan is always the same. Servan is waiting until the new content page is sufficiently downloaded, that is, Servan does not adjust the transfer speed of downloading. Therefore, in Servan, “data transfer speed while downloading” is not adjusted. As amended above, claim 17 recites “data transfer speed while downloading is adjusted...” in order to clarify the distinction between the features of claim 17 and Servan.

As described above, according to Servan, data transfer speed while downloading is not adjusted. Servan repeats displaying the same advertisement (“one or more downloaded advertising pages are displayed until the new content web page is ‘sufficiently’ downloaded”) if the transfer speed of downloading is slow. However, by applying the features recited in claim 17, the transfer speed of downloading is adjusted so as to be faster if the transfer speed of downloading is slow. Therefore, compared to Servan, the present application has a significant advantage in that it is possible to prevent the same advertisement from being repeatedly displayed.

Regarding Claim 18 (Paragraph No. 11), Applicant would like to point out that Claim 18 depends on Claim 17, and incorporates all of its features by reference. Therefore, although claim

18 is separately patentable, in the interest of brevity, the Applicant believes that Claim 18 should be allowed for at least the same reasons as Claim 17.

Regarding Claim 21 (Paragraph No. 12), this claim is cancelled without acquiescing in the propriety of the rejection, and without disclaimer or prejudice to the subject matter of the claim or its subsequent re-presentation in this or a continuing application.

Regarding Claim 23 (Paragraph No. 13), this claim is amended above commensurate with the amendments to claims 5. Applicant kindly refers to the above remarks made in respect of Claim 5, and further requests favorable reconsideration and withdrawal of the rejection.

Regarding Claim 28 (Paragraph No. 14), the claim depends on Claim 23, and incorporates all of its features by reference. Therefore, although claim 28 is separately patentable, in the interest of brevity, the Applicant believes that Claim 28 should be allowed for at least the same reasons as Claim 23.

Regarding Claim 35 (Paragraph No. 15), this claim is amended above commensurate with the amendments to claims 17. Applicant kindly refers to the above remarks made in respect of Claim 17, and further requests favorable reconsideration and withdrawal of the rejection.

Regarding Claim 36 (Paragraph No. 16), the claim depends on Claim 35, and incorporates all of its features by reference. Therefore, although claim 36 is separately patentable, in the interest of brevity, the Applicant believes that Claim 36 should be allowed for at least the same reasons as Claim 35.

Regarding Claim 39 (Paragraph No. 17), this claim is cancelled without acquiescing in the propriety of the rejection, and without disclaimer or prejudice to the subject matter of the claim or its subsequent re-presentation in this or a continuing application.

Regarding Claim 42 (Paragraph No. 18), this claim is amended above commensurate with the amendments to claim 6. Applicant kindly refers to the above remarks made in respect of Claim 6, and further requests favorable reconsideration and withdrawal of the rejection.

Regarding Claim 46 (Paragraph No. 19), the claim depends on Claim 40, and incorporates all of its features by reference. The Office Action does not allege that claim 40 is anticipated by Servan. Therefore, although claim 46 is separately patentable, in the interest of brevity, the Applicant believes that Claim 46 is distinguished over Servan for at least the same reasons as Claim 40.

Regarding Claim 53 (Paragraph No. 20), this claim is amended above commensurate with the amendments to claim 17. Applicant kindly refers to the above remarks made in respect of Claim 17, and further requests favorable reconsideration and withdrawal of the rejection.

Regarding Claim 54 (Paragraph No. 21), the claim depends on Claim 53, and incorporates all of its features by reference. Therefore, although claim 54 is separately patentable, in the interest of brevity, the Applicant believes that Claim 54 should be allowed for at least the same reasons as Claim 53.

In light of the foregoing, favorable reconsideration and withdrawal of the rejection over Servan is kindly requested.

Rejection under 35 U.S.C. § 103

Claims 3 and 21 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over Servan in view of U.S. Patent No. 6,360,221 to Gough, *et al.* ("Gough"). Applicant respectfully traverses the rejection, for at least the following reasons.

Regarding Claims 3 and 21 (Paragraph Nos. 22 and 23), these claims are cancelled, without acquiescing in the propriety of the rejection, and without disclaimer or prejudice to the subject matter of the claims or their subsequent re-presentation in this or a continuing application.

Claims 4 and 22 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over Servan in view of U.S. Patent No. 6,513,015 to Ogasawara ("Ogasawara"). Applicant respectfully traverses the rejection, for at least the following reasons.

Regarding Claims 4 and 22 (Paragraph Nos. 24 and 25), these claims are amended above commensurate with the amendments to claim 5. Applicant kindly refers to the above remarks made in respect of Claim 5. Even presuming that Gough teaches all that is attributed to it, and further that there is some objective reason to combine the references as recited in the Office Action, Servan and Gough, taken singly or in combination, do not teach or suggest all features of claims 4 and 22 as amended.

Claims 7, 11-16, 25, 29-34, 39-40 and 47-50 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over Servan in view of Official Notice. Applicant respectfully traverses the rejection, for at least the following reasons.

Regarding Claim 7 (Paragraph No. 26), the Examiner states that all the features of Claim 7 of the present application are disclosed by Servan. The Examiner further insists that it is “old and well known to present content in different formats...”. However, Applicant respectfully disagrees.

First, the Examiner states that “if the user's computer does not have the software ... a user may view the information in text or audio format or download the Flash software.” However, if the user views “the information in text or audio format”, advertisements are not sufficiently effective, or the user cannot understand the information because the information will be displayed in a broken format. Moreover, if the user tries to install Flash software, the user should access the Macromedia Web site and download the software. Such steps are manually conducted and take time. The system recited according to Claim 7 of the present application solves such a problem, because the information is displayed based on the user's environment.

Second, the Examiner insists that “if the user is using a different version of the Microsoft Word software on his computer, he might be asked to convert to a Word file ...”. However, this example is a file format conversion by Microsoft Word. Such a conversion is conducted in accordance with the user's command. Therefore, such a conversion is not automatically conducted. Moreover, if the version of Microsoft Word installed in the user's computer is old and the information he is trying to view is in a later Word format, such a conversion operation cannot be used. However, the system according to Claim 7 solves such problems, because the information is displayed based on the user's environment.

Additionally, Claim 7 is a dependent claim on Claim 4, and incorporates all of its features by reference. Even presuming that some evidence would support the naked allegations of Official Notice, and therefore teach all that is attributed, and further that there is some objective reason to combine the Servan and the ‘facts’ Noticed as proposed in the Office Action, this combination does not teach or suggest all features of claim 4, nor is it alleged to. Therefore, although claim 7 is separately patentable, in the interest of brevity, the Applicant believes that Claim 7 is distinguished for at least the same reasons as Claim 4.

Regarding Claim 11 (Paragraph No. 27), Claim 11 is dependent on Claim 4, and incorporates all of its features by reference. Therefore, although claim 7 is separately patentable, in the interest of brevity, the Applicant believes that Claim 7 is distinguished for at least the same reasons as Claim 4.

Regarding Claim 12 (Paragraph No. 28), the advertisement system of this claim is amended above to include "user side equipment for presenting advertisements constituted from interactive steps including one or a plurality of questions while transferring data with said server via said network". This amendment find support in the original specification as filed, e.g., pp. 8, 38, among other places. No new matter has been added. Such advertisements, including multiple steps of interactive questions, are not disclosed or suggested in Servan, nor are they old and well known. Therefore, Applicant respectfully submits that Claim 12 is patenably distinguished.

Claims 13 and 14 (Paragraph No. 29) depend on Claim 12, and incorporate all of its features by reference. Therefore, although claims 13 and 14 each separately patentable, in the interest of brevity, the Applicant believes that Claims 13 and 14 are distinguished for at least the same reasons as Claim 12.

Regarding Claim 15 (Paragraph No. 30), the Office Action states that all the features of Claim 15 of the present application are disclosed by Servan. The Office Action further states that it is "old and well known to execute sales of products or services to said user while data is transferred to or from said server ...". However, Applicant respectfully disagrees.

The Examiner describes an example using two internet browser windows. However, such operations are manually conducted by the user himself. Moreover, Applicant respectfully submits that this example is not Prior Art. Moreover, such an operation is confusing and takes time. There is a possibility in which the user orders a product while the user is viewing a web page of a different product. The system according to Claim 15 solves such problems.

In addition, Claim 15 depends on Claim 12, and incorporates all of its features by reference. Therefore, although claim 15 is separately patentable, in the interest of brevity, Applicant believes that Claim 15 is distinguished for at least the same reasons as Claim 12.

Regarding Claim 16 (Paragraph No. 31), the Office Action states that Claim 16 is "old and well known to perform a virus check on the user side equipment...". However, Applicant respectfully disagrees.

As amended above, claim 16 recites only “defragmenting” and “deleting unnecessary files”, not virus checking. The Office Action makes no allegation regarding these alternate features recited in the claim. Therefore, Applicant believes that Claim 16 is patentably distinguished.

Regarding Claim 25 (Paragraph No. 32), the Office Action offers examples of software such as Flash and Microsoft Word. However, Claim 25 includes “third instructions for selecting one or plurality of advertisements to present the user...” That is, Claim 25 relates to advertisements, not software. Even if it is possible to select software based on the environment, it is not possible according to the prior art or alleged Notice to select and show the appropriate advertisement based on the environment. Therefore, Applicant respectfully submits that Claim 25 is patentably distinguished, and should be allowed.

In addition, according to the features recited in Claim 25, for example, if Flash is not installed in a computer, an advertisement which needs Flash is not selected because such an advertisement is not appropriate to the environment. Even if software is selected by applying an old and well known method as stated by the Office Action, it is not possible to select an advertisement which does not need Flash.

If the advertisement is displayed in a text format as described in the rejection, in general, the advertisement is displayed in a broken format, and it is not possible to appeal to users. In Claim 25 of the present application, the advertisement is selected based on the environment, and it is possible to obtain an advantage to appropriately show the advertisement based on the environment.

Moreover, Claim 25 depends on Claim 23, and incorporates all of its features by reference. Therefore, although claim 25 is separately patentable, in the interest of brevity, Applicant believes that Claim 25 is distinguished for at least the same reasons as Claim 23. Claim 29 (Paragraph No. 33) also depends on Claim 23. Therefore, Applicant believes that Claim 29 should be allowed for at least the same reasons as Claim 23.

Regarding Claim 30 (Paragraph No. 34), as amended above, the advertisement is constituted from interactive steps of questions for response. This amendment finds support in the original specification as filed, for example at pp. 8, 38, among other places. However, it is not that case in e-marketing that advertisements are constituted from such questions. Therefore, Applicant respectfully submits that Claim 30 is patentably distinguished.

Claims 31 and 32 (Paragraph No. 35) depend on Claim 30, and incorporate all of its features by reference. Therefore, although claims 31 and 32 are each separately patentable, in the interest of brevity, Applicant believes that Claims 31 and 32 are distinguished for at least the same reasons as Claim 30. Claim 33 (Paragraph No. 36) depend on Claim 30 and likewise incorporate all of its features by reference. Therefore, although claim 35 is separately patentable, in the interest of brevity, Applicant believes that Claim 35 is distinguished for at least the same reasons as Claim 30.

Regarding Claim 34 (Paragraph No. 37), this claim is amended above commensurate with the amendments to claim 16. Applicant kindly refers to the above remarks made in respect of Claim 16, and further requests favorable reconsideration and withdrawal of the rejection.

Regarding Claim 39 (Paragraph No. 38), this claim is cancelled without acquiescing in the propriety of the rejection, and without disclaimer or prejudice to the subject matter of the claim or its subsequent re-presentation in this or a continuing application.

Regarding Claim 40 (Paragraph No. 39), this claim is amended above commensurate with the amendments to claim 22. Applicant kindly refers to the above remarks made in respect of Claim 22, and further requests favorable reconsideration and withdrawal of the rejection.

Regarding Claim 47 (Paragraph No. 40) this claim depends on Claim 41, and incorporates all of its features by reference. Therefore, although claim 47 is separately patentable, in the interest of brevity, Applicant believes that Claim 47 is distinguished for at least the same reasons as Claim 41 (noted above as presumptively allowable).

Regarding Claim 48 (Paragraph No. 41), this claim is amended above commensurate with the amendments to claim 30. Applicant kindly refers to the above remarks made in respect of Claim 30 , and further requests favorable reconsideration and withdrawal of the rejection.

Regarding Claims 49 and 50 (Paragraph No. 42), these claims depend on Claim 48, and incorporate all of its features by reference. Therefore, although claims 49 and 50 are each separately patentable, in the interest of brevity, Applicant believes that Claims 49 and 50 are distinguished for at least the same reasons as Claim 48.

Without prejudice to the foregoing remarks distinguishing the respective claims, Applicant renews its objection to the Office Action's continued unsubstantiated invocation of Official Notice, notwithstanding Applicant's seasonable objections. The Office has maintained its Official Notice for a third consecutive Office Action in the face of Applicant's repeated and

itemized objections (See, e.g., Applicant's August 23, 2007 response, pp. 16-17). If the facts Noticed were truly "capable of instant and unquestionable demonstration as being well-known," which the M.P.E.P. states is a prerequisite to taking Official Notice, it seems unusual that for a third consecutive Office Action, no documentary evidence is available. M.P.E.P., § 2144.03 (B).

The incantation of "Official Notice" is not sufficient to shift the Office's burden of making a *prima facie* rejection with regard to substantially all subject matter in 18 of the 32 pending claims. The Office Action misapplies Official Notice, by attempting to place on Applicant the nearly insurmountable burden of proving the negative, *i.e.*, disproving the hypothetical scenarios which the Office Action presents in support of its rejections. Applicant repeats its request, to the extent that the statements of Official Notice are drawn from Examiner's personal knowledge, for an affidavit or declaration pursuant to 37 C.F.R. §1.104(d)(2). M.P.E.P. §2144.03(E). However, Applicant believes such a request is obviated in view of the foregoing amendments and remarks.

Conclusion

In light of the foregoing, Applicant respectfully submits that the claims are patentable, and kindly solicits an early and favorable Notice of Allowability..

Respectfully submitted,

THIS CORRESPONDENCE IS BEING
SUBMITTED ELECTRONICALLY
THROUGH THE UNITED STATES
PATENT AND TRADEMARK OFFICE
EFS FILING SYSTEM
ON MARCH 12, 2008


MAX MOSKOWITZ
Registration No.: 30,576
OSTROLENK, FABER, GERB & SOFFEN, LLP
1180 Avenue of the Americas
New York, New York 10036-8403
Telephone: (212) 382-0700

MM/DJT:lf